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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,283	09/11/2003	Dhei-Jhai Lin	0698-0161P	5576
2292	7590	11/29/2004		EXAMINER
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			BREWSTER, WILLIAM M	
			ART UNIT	PAPER NUMBER
			2823	

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/659,283	LIN, DHEI-JHAI	
	Examiner	Art Unit	
	William M. Brewster	2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 October 2004.

2a) This action is **FINAL**.                                   2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) 12-25 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3,6-8 and 11 is/are rejected.

7) Claim(s) 4, 5, 9, 10 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All   b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 12-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 21 October 2004.

Applicant's election with traverse of claims 1-11 in the reply filed on 21 October 2004 is acknowledged. The traversal is on the ground(s) that there is no additional burden to examine all the claims in the application. This is not found persuasive because as cited in the restriction requirement, in claim 1, lines 3-12, "providing a removable mold . . . formed on the transparent substrate" may be accomplished with applying a coating and selectively etching for claim 12. Since the features in claim 12 will still require a different search than claim 1, the non-elected claims form an additional burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishikawa et al., US Patent No. 6,063,527.

Nishikawa anticipates 3. A method for making a color filter, and forming a patterned polymer layer on a transparent substrate, comprising the steps of: col. 7, line 63 – col. 10, line 3;

(1) in fig. 1B, providing a removable mold 13 having an intaglio surface with a plurality of groove units formed therein, the groove units being arranged in predetermined pattern;

(2) in fig. 1C, attaching the removable mold to a transparent substrate, thereby the intaglio surface and the transparent substrate 10 cooperatively forming a plurality of channel units;

(3) in fig. 1B, filling the channel units with a photopolymer solution containing colorants 14, col. 9, lines 52-63;

limitations from claim 2, the method wherein the photopolymer solution comprises colorants contained therein, col. 9, lines 52-63; limitations from claim 6, the method, in fig. 4, wherein in step (1), the groove units 29 are separated by partition walls, and the groove units comprises three types of grooves in correspondence with red, green, and blue sub-pixels: R, G, B, col. 11, lines 23-51;

limitations from claim 7, the method, wherein in step (3), in fig. 4, the three types of groove units are filled with corresponding red-colored, green-colored, and blue colored photopolymer solution, respectively, R, G, B, col. 11, lines 23-51;

, limitations from claim 8, the method, in fig. 1C, wherein the neighboring groove units of a same type communicate with each other via through holes defined in the removable mold, wherein the photopolymer 15 occupies the hole in between the grooves occupied by the solution of 14;

(4) in fig. 1C, applying an ultraviolet light to the photopolymer solution through the transparent substrate 10 so as to cure the photopolymer to the transparent substrate, col. 9, lines 52-63; and

(5) in fig. 1D, removing the removable mold with the patterned photopolymer layer formed on the transparent substrate.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa as applied to claims 1-3, 6-8 above.

Claim 11 is rejected as a "product by process" limitation.

Initially, with respect to claims a "**product by process**" claim is directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15. See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554, does not deal

with this issue); *In re Fitzgerald* 205 USPQ 594, 596 (CCPA); *In re Marosi et al* , 218 USPQ 289 (CAFC); and *In re Thorpe et al*, 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the patentability of the final product *per se* which must be determined in a "**product by process**" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above case law makes clear.

***Allowable Subject Matter***

Claims 4, 5, 9, 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Additional Prior Art***

Examiner notes with interest the prior art of Tomono et al. US Patent No. 6,078,377, especially figs. 9 A-H.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William M. Brewster whose telephone number is 571-272-1854. The examiner can normally be reached on Full Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 571-272-1855. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



19 November 2004  
WB